

In the Office Action, the Examiner has rejected claims 1, 3-7, 9-10, 13-16 and 21 under 35 USC §103(a) as being obvious over U.S. Patent No. 4,909,405 to Kerr, Jr. ("Kerr") in view of U.S. Patent No. 5,803,653 to Zuffetti ("Zuffetti").

Kerr has been cited by the Examiner to show a hanger bar assembly for supporting an outlet box space between support elements having a first channel extending into a second channel. The Examiner further contends that Kerr discloses a clamping device (68) including a bracket that is slidably positionable over the support bar and a fastener (74) securable with the bracket such that upon securing the fastener to the bracket the first and second channel members are clamped together. The Examiner also indicates that the first and second channel member each have similar cross-sectional profiles.

The Examiner notes, however, that Kerr does not show that the first channel member has a plurality of longitudinally extending first grooves and a plurality of longitudinally extending first rails, the second channel member having a plurality of longitudinally extending second rails and a plurality of longitudinally extending second grooves with the first rails being slidably received and the second rails being slidably received in the first groove to resist rotational movement.

Zuffetti has been cited for disclosing of channel-shaped members (2) that are slidably engageable wherein the first channel member has a plurality of longitudinally extending first grooves and a plurality of longitudinally extending first rails. The interrelation between the grooves and the channels of Zuffetti prevent rotation between the first and second members. Accordingly, the Examiner contends that it would have been obvious to someone skilled in the art to use the teachings of Zuffetti to modify the channel members of Kerr by modifying the shape in order to prevent rotation between the channel members.

Applicants respectfully traverse the rejection under §103(a) since it would not have been obvious to combine the references as suggested by the Examiner. Applicants further submit that each element of the rejected claims is not found alone or in combination in the cited references.

In order to properly combine or modify prior art references, there must be a teaching to do so in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). However, if a proposed modification or combination would change the principle of operation or render the prior art invention unsuitable for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Ratti*, 270 F.2d 810 (CCPA 1959), *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). In the present application, the proposed modification of Kerr in view of Zuffetti would to change the principle of operation of the Kerr device as to make it usable for its intended purpose.

The Kerr reference is directed to a hanger bar which can be used in old work installation in which the joists are covered and access there to is through a hole in the ceiling. See Figure 2. The hanger bar includes two round tubular members with one received rotatably within the other. The end of each of the tubular members are screwed into the spaced joists in order to secure the hanger bar in a ceiling as shown in Figure 3. The manner in which the attachment takes place is set forth in the specification in Col. 6, lns 30-61. First one end is urged against the joist and the tubes are rotate in unison causing screw 24 to penetrate joist 64. Col. 6, lns. 38-44. Then the tubular members are expanded until the opposite screw 52 engages joist 66. Col. 6, lns. 44-47. Hand rotation of tube 14 alone causes screw 52 to penetrate joist 66 thereby anchoring the hanger bar assembly. Col. 6, lns. 48-52. Therefore, tube 14 rotates independently of tube 12, and this permits proper installation of the hanger bar.

Zuffetti discloses a pair of U-shaped interlocking channels which prevent relative rotation between the channels. By combining the U-shaped channel configuration of Zuffetti with Kerr, the ability to rotate and thus install the Kerr device would not be achievable. When one end was installed, the other end could not be rotated by tuning the other channel as required by the Kerr patent, therefore, proper installation would not be achievable. Thus Kerr's principle of operation would be significantly changed and the device would be unsatisfactory for its intended purpose. Accordingly, the proposed combination of references is improper, and Applicants respectfully request that the rejection under §103 be withdrawn.

Additionally, Applicants respectfully submit that the proposed prior art combination does not teach or suggest all the claim limitations. With reference to independent claims 1, 10, 15, 17 and 21, a clamping device or clamp is claimed which urges the channel member into engagement to restrict relative movement thereof. This feature is not found in either Kerr or Zuffetti.

The Zuffetti patent is directed to a telescopic mount for temporary walls and the disclosed two U-shaped channels are telescopically received within one another. There is no clamping device shown which urges the members into engagement to prevent relative movement therebetween. The only manner which prevents the relative movement between the channels appears to be the use of dry wall screws or nails as shown in Figure 5.

With regard to Kerr, the saddle (68) sits on top of tube 14 and is secured thereto by a fastener and the outlet box as shown in Figure 3. However, the saddle does not act as a clamping device for urging the first and second members into respective forced engagement to restrict movement between the first and second channel members. The saddle sits over, and engages, only one of the tubes. There is no teaching that the saddle and the manner in which it is to be attached would bring the outer tube into engagement

00/12/2005 THU 10:43 FAX 5168223550
Application Serial No.: 09/899,862
Filing Date: July 6, 2001
Docket: 577-516 (T&B 1632)
Page 5 of 5

with the inner tube. Furthermore, the specification specifically says that "once the hanger bar assembly is fully secured in a position, the saddle (68) would be normally located overlying the opening (60)." Column 6, lines 55-57. Therefore, there is no teaching that the saddle and box combination is to be employed to prevent relative movement of the tubes which would assist in securing the hanger bar in place. Accordingly, Applicants respectfully submit that claims 1, 10, 15, 17 and 21, and those claims depending therefrom, patentably distinguish over the references of record.

In light of the comments set forth above, Applicants respectfully request favorable reconsideration of the rejected claims and allowance of the application with claims 1-23.

If the Examiner believes that a telephone interview would be helpful in moving the case toward allowance, she is respectfully invited to contact Applicants' attorney at the telephone number set forth below.

Respectfully submitted,



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